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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/815,454

03/22/2001

Viyyokaran Raman Ramachandran

6647-20

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45842

7590

01/10/2007

MARGER JOHNSON & MCCOLLOM, P.C. - NOVELL

210 SW MORRISON STREET

SUITE 400

PORTLAND, OR 97204

EXAMINER

JUNG, DAVID YIUK

ART UNIT

PAPER NUMBER

2134

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
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3 MONTHS

01/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/815,454

Applicant(s)

RAMACHANDRAN ET AL.

Examiner

David Y. Jung

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

CLAIMS PRESENTED

Claims 1-47 are presented.

Record of Art

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Response to Arguments

Applicant's arguments as filed have been fully considered but they are deemed insufficient to be persuasive at the moment.

The main issue is that Applicant has asserted a point that Applicant has directly refused to support with an affidavit: Windows 2000 (as evidenced by the cited references in the prosecution history of this application) did not have federation policy regarding user authentication across domains. Yet, the following seems to be accepted by Applicant:

1. Already in the year 2000, before the filing date of this application, Windows 2000 as reported to the media (as evidenced by the cited references in the prosecution history of this application) had federation policy regarding user authentication across domains.
2. Claims of this application would not be patentable if Windows 2000 in the year 2000 (as evidenced by the cited references in the prosecution history of this application) had federation policy regarding user authentication across domains.

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Applicant has provided legal arguments on why the Windows 2000 as reported to the media (as evidenced by the cited references in the prosecution history of this application) cannot be prior art, especially if the media reports were published after the filing date of the application. Furthermore, Applicant has provided legal arguments on why Applicant should not be required to provide an affidavit on this matter.

The Office, after an unusually difficult consideration, must respectfully disagree with Applicant. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

These four factual inquiries certainly require that the Examiner establish the date of the prior art. Applicant notes that MPEP states so. After the Examiner establishes the date of the subject matter of the prior art, the actual publication date of the prior art does not seem to be relevant. For example, if there is no dispute that the subject matter of the prior art is before the filing date of this application, then the actual publication date of the prior art does not seem to be relevant. Thus, the real question seems to be: what is the credibility of the prior art documents that have been cited in the prosecution history of this application?

On this critical question, the Office decides at this time against Applicant. After an unusually difficult consideration, the Office decides at this time in favor of the

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credibility of the prior art documents that have been cited in the prosecution history of this application.

Thus, the claims are rejected.

CLAIM REJECTIONS

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-47 are rejected under 35 U.S.C. 103(a) as being unpatentable as stated in the most previous Office Action with rejections under 35 U.S.C. 103(a).

Conclusion

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Jacques Louis-Jacques whose telephone number is (571) 272-6962.

David Jung

Patent Examiner

A handwritten signature in black ink, consisting of a large loop followed by a horizontal line that tapers off to the right.

1/7/07